



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/499,468	02/07/2000	Ralph Alderson	PF112U1	1320

22195 7590 08/24/2004  
HUMAN GENOME SCIENCES INC  
INTELLECTUAL PROPERTY DEPT.  
14200 SHADY GROVE ROAD  
ROCKVILLE, MD 20850

EXAMINER

LANDSMAN, ROBERT S

ART UNIT	PAPER NUMBER
----------	--------------

1647

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/499,468

Applicant(s)

ALDERSON ET AL.

Examiner

Robert Landsman

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 42-44, 46-54, 56-64, 66-71 and 73-75 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 42-44, 46-54, 56-64, 66-71 and 73-75 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***1. Formal Matters***

- A. The Amendment dated 7/22/04 has been entered into the record.
- B. Claims 42-44, 46-54, 56-64, 66-71 and 73-75 are pending and are the subject of this Office Action.
- C. All Statutes under 35 USC not found in this Office Action can be found, cited in full, in a previous Office Action.

### ***2. Claim Rejections - 35 USC § 112, first paragraph – scope of enablement***

- A. The rejection of claims 42-44, 46-54, 56-64, 66-71 and 73-75 are withdrawn in view of Applicants' amendments to the claims to limit the scope to methods of treating patients with degenerate photoreceptor cells.

### ***2. Claim Rejections - 35 USC § 112, first paragraph – new matter***

- A. Claims 42-44, 46-54, 56-64, 66-71 and 73-75 remain rejected under 35 USC 112, first paragraph, for the reasons already of record on pages 3-4 of the Office Action dated 4/28/04. Applicants argue that amino acids 108-188 of SEQ ID NO:2 correspond to the domain containing the 8 conserved cysteines and that this domain is discussed throughout the application.

This argument has been considered, but is not deemed persuasive. Though a domain containing 8 cysteines may be referred to in the specification, nowhere in the specification does it refer to this exact domain. Residues 80-188 neither end, nor begin, with cysteines. Furthermore, it appears that this region contains 9 cysteines.

Though claims 52-54, 56-64, 66-71, 74 and 75 were encompassed by this rejection, no particular rejection was made for the use of the fragment comprising residues 80-202 or 9-396. However, as with residues 80-188, these sequences also constitute new matter.

### ***3. Claim Rejections - 35 USC § 112, second paragraph***

- A. All rejections under 35 USC 112, second paragraph, have been withdrawn in view of Applicants' amendments to, or cancellation of, the claims.

Art Unit: 1647

**4. Conclusion**

A. No claim is allowable.

***Advisory information***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Landsman whose telephone number is (571) 272-0888. The examiner can normally be reached on Monday - Friday from 8:00 AM to 5:00 PM (Eastern time) and alternate Fridays from 8:00 AM to 5:00 PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Brenda Brumback, can be reached on (571) 272-0961.

Official papers filed by fax should be directed to (703) 872-9306. Fax draft or informal communications with the examiner should be directed to (571) 273-0888.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-0700.

Robert Landsman, Ph.D.  
Patent Examiner  
Group 1600  
August 24, 2004

  
ROBERT LANDSMAN  
PATENT EXAMINER